REMARKS

RESTRICTION REQUIREMENT AND ELECTION:

In this Office action, the Examiner has imposed a restriction requirement dividing the claims into two groups, one group consisting of claims 1-8, 24-26 and 38-59, and the second group consisting of claims 27-37 and 60-70. The Examiner considered the claims of the first group, claims 1-8, 24-26 and 38-59.

In the previous Office Action dated May 13, 2003, the Examiner has also issued a restriction requirement, dividing the claims into two groups consisting of claims 1-8 and claims 9-23 respectively. In response to that Office Action, Applicants argued that this restriction requirement was not supported by the claimed invention as recited in claims 1-23.

Applicants still believe that, although an election of claims 1-8 was apparently done without traverse by prior counsel, a clarification of the claims would have all together obviated these restriction requirements and elections.[1] Notwithstanding, to allow Examination of this application to move forward Applicants have cancelled claims 27-37 and 60-70 without prejudice or surrender of any subject matter and reserve the right to present the unelected claims in a continuation/divisional application.

STATUS OF THE CLAIMS

Applicants amended claim 46 to correct a typographical error, as pointed out by the Examiner. Claims 71 and 72 have been added to further point out various aspects of the invention. Accordingly, claims 1-8, 24-26, 38-59, 71 and 72 are now pending examination.

CLAIM REJECTIONS UNDER 35 USC §102

In this Office Action claims 38-40, 43, 44, 46 and 48, have been rejected under 35 USC §102 as being anticipated by U.S. Patent 6,061,660 Eggleston. However, Eggleston does not support this claim rejection, as will be explained below. In particular, Eggleston does not anticipate nor does it enable claims 38-40, 43, 44 and 46.

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[1] Applicants' arguments to that effect as provided in Applicants' response dated August 25, 2003, are incorporated herein by reference.

As to claim 38, for example, although Eggleston discloses a host computer (18) and one or more consumer and sponsor sites, Eggleston does not disclose an "auction server" or "a web server from which the auction web server and store web server are accessible to a user, the web server, in turn, being accessible to the user from either or both of the auction server and the store web server." Indeed, as defined in Eggleston, a "client" encompasses any system for establishing communication to an Internet site, and a "host" system permits sponsoring companies to offer incentive programs to consumers and, to that end, it stores files for implementing a consumer site, a sponsor site and an award site (Eggleston, col. 7, 18-25, and col. 8, lines 13-20). A consumer operating a browser locates a consumer site for registration to become a member of the host incentive program system, where the consumer site has hyperlinks to other sites, e.g., incentive programs from the directory of programs provided by the host or third parties (Eggleston, col. 12, lines 12-37). In other words, to get to a one of the different sites, a client visits a consumer site and from there it uses a link to the next site. By contrast, in the system of claim 38, the web server is accessible to the user from either or both of the auction server and the store web serve and, in addition, from the a web server the auction web server and store web server are accessible to a user. Eggleston also does not specifically disclose points being characterized as "purchase" points. Finally, because Eggleston does not teach or suggest, explicitly or implicitly, all the elements of the system as recited in claim 38 it does not enable producing such system. Thus, Eggleston does not anticipate claim 38.

Likewise, Eggleston does not teach or suggest all the limitations of the on-line off-line incentive points system as recited in claim 43. Specifically, Eggleston does not disclose "a server... having a web server; a messaging server and a database server, wherein the web server interfaces with the network, messaging server and database server." Instead, Eggleston discloses a host site with hyperlinks to one or more other sites (Eggleston, col. 12, lines 12-37). Additionally, Eggleston does not teach or suggest the combination of databases serviced by the database server as recited in claim 43, namely, "an account database, one or more auction databases, an incentive points database, a coupon database, a seller data base, a merchandise database, a bid database." Instead, Eggleston discloses consumer registration records (name, ID, password, account number), sub-records (historical participation in incentive programs) winning sub-records, award or points sub-records, demographics sub-records, and consumer and sponsor

databases (Eggleston, col.13, lines 1-60). It is not surprising why Eggleston does not teach or suggest, for example, the auction database or bid database; Eggleston is directed to implementing and using incentive programs but not auctions. In view of its failure to teach or suggest, explicitly or implicitly, all the elements of the system of claim 43 and its further failure to enable such system, Eggleston does not anticipate claim 43.

As to claim 44, which depends from claim 43, Eggleston maintains program codes for creating incentive programs (based on parameters specified by the sponsors), which is entirely different from "code server including a code database...for maintaining valid codes against which a code submitted by a user is verifiable" (Eggleston, e.g., col. 29, line 51 to col. 30, line 65).

In general, failure to teach or suggest all the limitations of the independent claims also results in the failure to teach or suggest all the limitations of the dependent claims. In other words, Eggleston does not anticipate claims 38, 38 and 43 and, likewise, it does not anticipate dependent claims 39, 40, 44-46.

CLAIM REJECTIONS UNDER 35 USC §103

Further in this Office Action, claims 1-8, 24-26 and 50-59 have been rejected under 35 USC §103 as being unpatentable over U.S. Patent 5,996,997 to Kamille in view of Eggleston. Kamille, however, does not support this claim rejection, either singly or in combination with Eggleston and alleged knowledge in the art, as will be explained below.

As indicated once before and as acknowledged by the Examiner in this office action,[2] Kamille does not teach or suggests all the limitations of claims 1-8, 24-26 and 50-59, and Eggleston does not make up for Kamille's deficiency. Firstly, the proposed combination of Kamill and Eggleston is improper,[3] and, secondly, Eggleston does not teach the elements missing from Kamille even if the proposed combination would have been proper.

For example, claim 1 recites an offline-online points system that includes

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[2] Office Action, pages 2, section 1, and pages 5 et seq.

[3] Kamille U.S. Class 273/139; Eggleston U.S. Class 705/14. On one hand, Kamille is directed to a probability game system for redeeming a validated game piece on which there is wining a value indication (see, e.g. Figures 1-4C, abstract, and col. 12, lines 15-41). Once Kamille's wining value is exposed on the game piece and the winning value is redeemed, assuming the game piece has been validated, the game piece is no longer valuable. On the other hand, Eggleston is directed to implementing (creating and instantiating) incentive programs purchased by

a main server configured for providing a user with an interface to submit a code, wherein the code is obtainable offline and is associated with N points, wherein each point, characterized as a purchase or attention incentive point, is redeemable and maintainable in an account for the user; and

a code server configured for maintaining valid codes and verifying that the code submitted by the user is a valid code such that a balance in the account for the user is increased by a predetermined number of points if the code is a valid code.

Kamille, on the other hand, does not teach or suggests terms such as "server", "interface", "points", "account", or "balance". Indeed, Kamille, unlike the offline-online points system of claim 1, discloses a probability game system for redeeming a validated game piece on which there is wining a value indication (see, e.g. Figures 1-4C, abstract, and col. 12, lines 15-41). Kamille does not accumulate points in return for a valid code submission nor does it maintain an account of redeemable points, characterized as a purchase or attention incentive points. Once Kamille's wining value is exposed on the game piece and the winning value is redeemed, assuming the game piece has been validated, the game piece is no longer valuable . Eggleston also does not teach or suggest accumulation of points once the code is validated (respectfully, nothing in col. 35, lines 21-49, suggests validation of code and accumulation of points once the code is validated). In the present invention, the points are accumulated once the code is validated and redeemable at some point in the future.

Consistent with the accumulation of points in a user account, as recited in claims depending from claim 1, e.g., claims 2-4, the offline-online points system of claim 1, further includes a user database. The database is configured for holding the account for the user, wherein the balance of the account is M points prior to the user's submission of the code and is M+N points once the code is validated. By contrast, Kamille does not disclose a database nor does it disclose the addition of N points to the balance, M, of a user account once the code is validated, so that the balance increases to M+N points.[4] Indeed, Kamille does not even mention the terms "account" or "balance" and such terms cannot be attributed to Kamille; Eggleston does not mentions this either.

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sponsors, instantiating consumer and sponsor web sites and accessing these website to interact with same for registration and obtaining awards..

[4]Kamille, , e.g., col. 3, lines 18-35, col. 5, lines 30-47, and col. 12, lines 15-41

In other words, Kamille does not teach or suggest the claimed invention as recited in claims 1-8 and 24-26, either singly or in combination with Eggleston. Additionally, Applicants respectfully object to the Examiner's allegation that encryption was known in the art and thus it was obvious to combine this knowledge with the teachings of the cited references to produce the claimed invention as recited in claims 24 (and 51). Mere knowledge of the existence of encryption is not enough. There is no support anywhere in the references for employing encryption in the context of an offline-online incentive pints system as recited and described in the present application, and no other support for such allegation has been provided by the Examiner. In other words, a proposed combination of knowledge in the art about encryption with the teachings of the cited references in order to produce the claimed invention cannot avoid impermissible use of hindsight gleaned from the present invention. A similar objection is made as to the Examiner's allegation that incentive playing pieces are well known (e.g., bottle cap) and render claims 26 (and 59) obvious for this reason.

As to the method claims, Kamille and Eggleson, singly or in combination, fail to teach or suggest the method of claim 50 and, in particular:

> submitting the code online to a server that has valid codes, wherein the code is associated with N points maintained by the server in a user account, wherein each point, characterized as a purchase or attention incentive point, is redeemable; and
> verifying the submitted code against the valid codes to determine if it is valid, wherein if the submitted code is valid, a predetermined number of points are added to the user account.

Stated another way, the combined teachings of Kamille and Eggleston, even if it were proper, fail to teach or suggest: "a server that has valid codes, wherein the code is associated with N points maintained by the server in a user account...if the submitted code is valid, a predetermined number of points are added to the user account."

In view of the forgoing, claims 1 and 50 and their respective dependent claims 2-8, 24-26 and 51-59 are not rendered obvious by the cited references, singly, combined, or in further combination with any alleged knowledge in the art. Moreover, by analogy, new claims 71 and 72 are not rendered obvious by these references.
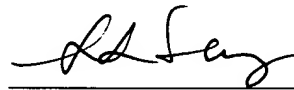
CONCLUSION

For these reasons, claims 1-8, 24-26, 38-59, 71 and 72, are allowable over the cited reference and alleged knowledge in the art. Thus, as the application is believed to be ready for allowance, a Notice of Allowance of these claims is hereby respectfully requested.

Authorization is hereby given to charge any fee deficiency or credit any overpayment to Deposit Account 50-2778. Should any matter remain unresolved or if any question remains unanswered the Examiner is kindly invited to contact the undersigned Applicant's attorney at (650) 813-4873.

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Respectfully submitted

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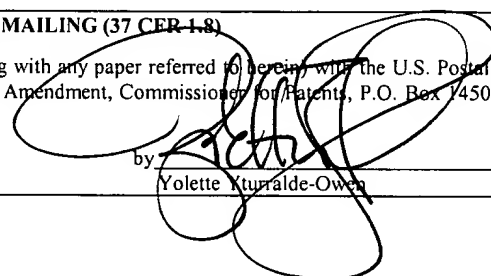**Customer No. 37509**
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